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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,144	02/27/2004	Jeffrey A. Tilton	25353A	9228

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OWENS CORNING  
2790 COLUMBUS ROAD  
GRANVILLE, OH 43023

EXAMINER
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PIZIALI, ANDREW T

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/789,144

Applicant(s)

TILTON ET AL.

Examiner

Andrew T. Piziali

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 6, 7, 14 and 16-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-13 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/30/2004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, Species 1 from Species Group I, and Species 1 from Species Group II, in the reply filed on 8/5/2005 is acknowledged. The traversal is on the grounds that the subject matter of claims 1-37 is sufficiently related and that a search for the subject matter of any of the groups of claims would encompass a search for the subject matter of the remaining claims. This is not found persuasive because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification. Claims 6-7, 14 and 16-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention and/or species.

The requirement is still deemed proper and is therefore made FINAL.

### ***Specification***

2. The disclosure is objected to because of the following informality: On page 8, line 2, the specification states that Figure 4 shows the ribs 6 and 16 extending parallel to one another, but Figure 4 does not show ribs 6 and 16 extending parallel to one another. Appropriate correction is required.

3. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to mention a wet compression percentage, a dry compression percentage, or a dry wet recovery percentage (see claims 9-11). Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 3, 5, 12-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 4,474,846 to Doerer et al. (hereinafter referred to as Doerer).

Regarding claims 1, 3, 5, 12-13 and 15, Doerer discloses a liner/insulator comprising a base layer of fibrous material and a plurality of ribs of fibrous material thermally bonded to the base layer (see entire document including column 3, lines 12-38, column 4, lines 21-57, and column 6, lines 9-24).

Regarding claim 3, Doerer discloses that the fibrous material may consist of a mixture of natural fibers and polyester, polyethylene, or polypropylene (column 4, lines 21-57).

Regarding claim 5, Doerer discloses that the ribs may extend parallel to one another (column 6, lines 9-24).

Regarding claim 12, Doerer does not specifically mention using the liner/insulator as an automotive undercarpet, but Doerer does disclose that the liner/insulator may be used in automotive applications as a thermal and acoustic insulator (column 3, lines 12-38). Therefore, it appears that the liner/insulator taught by Doerer can be considered an automotive undercarpet.

Regarding claim 13, Doerer does not specifically mention making the liner/insulator from scrap fibrous material, as opposed to an “in line” method, but Doerer does disclose that the liner/insulator is made of a fibrous material (column 4, lines 17-20). It is the examiner’s position

Art Unit: 1771

that the article of the applied prior art is identical to or only slightly different than the claimed article. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show obvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983). The applied prior art either anticipated or strongly suggested the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with the applied prior art.

Regarding claim 15, Doerer discloses that the liner/insulator may be a nonlaminated (column 7, lines 49-52).

6. Claims 1, 3, 5, 12-13 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by USPN 5,660,908 to Kelman et al. (hereinafter referred to as Kelman).

Regarding claims 1, 3, 5, 12-13 and 15, Kelman discloses a liner/insulator comprising a base layer of fibrous material and a plurality of ribs of fibrous material thermally bonded to the base layer (see entire document including column 1, lines 41-49, column 2, lines 38-47, and column 3, lines 48-57).

Art Unit: 1771

Regarding claim 3, Kelman discloses that the fibrous material may be PET (column 2, lines 10-22).

Regarding claim 5, Kelman discloses that the ribs may extend parallel to one another (Figure 3).

Regarding claim 12, Kelman does not specifically mention using the liner/insulator as an automotive undercarpet, but since the claim fails to further structurally define the liner/insulator, it appears that the liner/insulator taught by Kelman can be considered an automotive undercarpet.

Regarding claim 13, Kelman does not specifically mention making the liner/insulator from scrap fibrous material, as opposed to an "in line" method, but Kelman does disclose that the liner/insulator is made of a fibrous material (column 2, lines 10-22). It is the examiner's position that the article of the applied prior art is identical to or only slightly different than the claimed article.

Regarding claim 15, Kelman discloses that the liner/insulator may be a nonlaminated (Figure 3).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 2 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,474,846 to Doerer as applied to claims 1, 3, 5, 12-13 and 15 above, and further in view of USPN 6,497,950 to Haile et al. (hereinafter referred to as Haile).

Art Unit: 1771

Regarding claims 2 and 9-11, Doerer discloses the use of carrier fibers made of thermoplastic material (see entire document including column 4, lines 21-57) and discloses that other fibers may be added based on the desired characteristics (column 3, lines 64-66), but Doerer does not specifically mention bicomponent fibers. Haile discloses that it is known in the headliner art to use continuous and/or staple bicomponent fibers, with or without glass fibers, and discloses that bicomponent fibers provide nonwoven fabrics having good integrity and bond strength (column 1, line 45 through column 2, line 8, column 12, lines 10-20, and column 13, line 32-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fibers from any suitable fiber material, such as continuous and/or staple bicomponent fibers, with or without glass fibers, because it has been held to be within the general skill of a worker in the art to select known materials on the basis of its suitability and because bicomponent fibers provide nonwoven fabrics having good integrity and bond strength.

Regarding claims 9-11, Doerer does not specifically mention the wet compression percentage, dry compression percentage, or dry wet recovery percentage, but considering that the liner/insulator taught by the applied prior art is identical to the claimed liner/insulator in terms of structure and materials, it appears that the liner/insulator taught by the applied prior art inherently possesses the claimed properties.

The Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on

Art Unit: 1771

inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

9. Claims 4 and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 4,474,846 to Doerer as applied to claims 1, 3, 5, 12-13 and 15 above, and further in view of USPN 5,892,187 to Patrick.

Doerer is silent with regards to the distance between ribs and the width of the ribs, therefore, it would have been necessary and thus obvious to look to the prior art for conventional distances between ribs and rib widths. Patrick provides this conventional teaching showing that it is known in the headliner art to vary the distance between ribs, and the width of the ribs, based on the desired sound or noise to be attenuated (see entire document including column 4, lines 52-67 and column 5, lines 44-57). Patrick specifically discloses that the width of the ribs may be about 22 mm or less (0.87 inches or less) and illustrates a distance between the ribs about equal to the specifically mentioned rib width (column 5, lines 44-57 and Figures 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the ribs spaced apart at least about 0.25 inches and with a width of between about 0.5 to about 3.0 inches, as taught by Patrick, motivated by the expectation of successfully practicing the invention of Doerer and based on the desired sound or noise to be attenuated.



Art Unit: 1771

10. Claims 2 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,660,908 to Kelman as applied to claims 1, 3, 5, 12-13 and 15 above, and further in view of USPN 6,497,950 to Haile.

Regarding claims 2 and 9-11, Kelman discloses the use of fibers made of PET (column 2, lines 10-22), but Kelman does not specifically mention bicomponent fibers. Haile discloses that PET fibers are not suitable for headliner applications because of the high temperatures associated with closed cars parked in hot climates (column 1, line 65 through column 2, line 8). Haile also discloses that it is known in the headliner art to use continuous and/or staple bicomponent fibers, with or without glass fibers, and discloses that polyester bicomponent fibers provide nonwoven fabrics having good integrity and bond strength while eliminating the problems associated with PET fibers (column 1, line 45 through column 2, line 8, column 12, lines 10-20, and column 13, line 32-57). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the fibers from any suitable fiber material, such as continuous and/or staple bicomponent fibers, with or without glass fibers, because it has been held to be within the general skill of a worker in the art to select known materials on the basis of its suitability and because bicomponent fibers provide nonwoven fabrics having good integrity and bond strength.

Regarding claims 9-11, Kelman does not specifically mention the wet compression percentage, dry compression percentage, or dry wet recovery percentage, but considering that the liner/insulator taught by the applied prior art is identical to the claimed liner/insulator in terms of structure and materials, it appears that the liner/insulator taught by the applied prior art inherently possesses the claimed properties.

Art Unit: 1771

11. Claims 4 and 8, are rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,660,908 to Kelman as applied to claims 1, 3, 5, 12-13 and 15 above, and further in view of USPN 5,892,187 to Patrick.

Kelman is silent with regards to the distance between ribs and the width of the ribs, therefore, it would have been necessary and thus obvious to look to the prior art for conventional distances between ribs and rib widths. Patrick provides this conventional teaching showing that it is known in the headliner art to vary the distance between ribs, and the width of the ribs, based on the desired sound or noise to be attenuated (see entire document including column 4, lines 52-67 and column 5, lines 44-57). Patrick specifically discloses that the width of the ribs may be about 22 mm or less (0.87 inches or less) and illustrates a distance between the ribs about equal to the specifically mentioned rib width (column 5, lines 44-57 and Figures 1-3). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to make the ribs spaced apart at least about 0.25 inches and with a width of between about 0.5 to about 3.0 inches, as taught by Patrick, motivated by the expectation of successfully practicing the invention of Kelman and based on the desired sound or noise to be attenuated.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew T. Piziali whose telephone number is (571) 272-1541. The examiner can normally be reached on Monday-Friday (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571) 272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1771

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

atp

g72 8/22/05  
**ANDREW T. PIZIALI**  
**PATENT EXAMINER**